

REMARKS

Claims 1-4 and 10-18 are all the claims presently pending in the application.

Applicants have canceled claims 5-9 and 19 without prejudice or disclaimer.

Applicants have amended claims 1 10, 11, 13, 16, and 18 to define the claimed invention more particularly.

Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 9 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-19 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Claims 1-19 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claims 1-8, 11-16, 18, and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Stiller et al. (Surface and Interface Analysis, 2000; hereinafter “Stiller”). Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hugel et al. (Science, May 2002; hereinafter “Hugel”). Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiller. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiller in view of Nakagawa (U.S. Patent No. 5,353,632).

Applicants respectfully traverse these rejections in the following discussion.

I. THE 35 USC §112, FIRST PARAGRAPH REJECTION

The Examiner alleges that the claimed invention of claim 9 as not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and use the invention.

Applicants submit that the claimed invention of claim 9 is clearly enabled by the disclosure of the originally filed application. Applicants point out, however, that Applicants have canceled claim 9 by the present amendment, thus rendering the Examiner's rejection moot.

The Examiner alleges that claimed invention of claims 1-19 was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and use the invention. The Examiner, however, is clearly incorrect.

Applicants maintain the traversal arguments included in the Amendment filed on December 7, 2006 and the Amendment filed on March 19, 2007, the substance of which is incorporated herein by reference.

Furthermore, Applicants submit that the Notice of Panel Decision from Pre-Appeal Brief Review clearly indicates that this rejection "is withdrawn".

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

II. THE 35 USC §112, SECOND PARAGRAPH REJECTION

The Examiner alleges that the claimed invention of claims 1-19 is indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the claimed invention.

The Examiner, with respect to claim 1, alleges that the term "probe" is indefinite. Applicants submit again, however, that when considering whether a term is indefinite the Examiner must consider the claim language in view of the teachings of the specification. The term probe is clearly defined in the specification at page 11, lines 4-18.

Similarly, with respect to claim 2, the term “line”, as recited in the claimed invention, is clearly defined in the Specification (e.g., see Application at page 13, lines 18-23).

The Examiner is reminded that:

“A fundamental principal is that applicants can be their own lexicographers. Applicants may define their invention, in the claims, essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. A claim may not be rejected solely because of the type of language used to define the claimed invention.” (See M.P.E.P. § 2173.01; emphasis added by Applicants).

With respect to claim 5, Applicants again point out when considering whether a term is indefinite the Examiner must consider the claim language in view of the teachings of the specification. This feature is clearly illustrated in Figures 1 and 2 (e.g., reference number 130; e.g., Applicants submit that reference numbers are merely provided for the aid of the Examiner and are not meant or intended to limit the scope of the claimed invention in any manner) of the Application. Furthermore, the claim clearly recites “a moiety located between the two arms”. Applicants cannot understand how this limitation is not understood.

The claimed invention (e.g., as illustrated in Figure 1A) includes two arms (e.g., 110) with a moiety (e.g., 130) disposed between the two arms at one end of the arms. A space is provided between the two arms at the opposite end of the two arms. This is clearly disclosed in the Application (e.g., see Figures 1 and 2, and page 12, lines 12-17).

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. PRIOR ART REJECTIONS

A. The Stiller Reference

The Examiner alleges that Stiller teaches the claimed invention of claims 1-8, 11-16, 18, and 19. Furthermore, the Examiner alleges that Stiller renders obvious the claimed invention of claim 10. Applicants respectfully submit, however, that Stiller does not teach or suggest (nor render obvious) each feature of the claimed invention.

That is, Stiller does not teach or suggest, “*a light-sensitive compound, said light-sensitive compound comprising: two arms, each of said two arms comprising an azo double bond; and a moiety located between the two arms*”, as recited in exemplary claim 1.

Indeed, Stiller merely teaches a 4-fluoro-methyl-4-(10-mercaptodecyl-oxy) azobenzene (e.g., see Stiller at Figure 1). The compound disclosed in Stiller does not have the same structure as that of the claimed invention.

Indeed, the compound disclosed in Stiller does not include two arms, where each of the two arms include an azo double bond, and a moiety disposed between the two arms.

Therefore, Applicants submit that the Stiller does not teach or suggest each feature of the claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw these rejections.

B. The Hugel Reference

The Examiner alleges that Hugel teaches the claimed invention of claims 1-4. Applicants respectfully submit, however, that Hugel does not teach or suggest each feature of the claimed invention.

That is, Hugel does not teach or suggest, “*a light-sensitive compound, said light-sensitive compound comprising: two arms, each of said two arms comprising an azo double bond; and a moiety located between the two arms*”, as recited in exemplary claim 1.

Indeed, the Examiner does not even allege that Hugel teaches or suggests these features of the claimed invention, which were previously recited in dependent claims 5 and 10 (not rejected based on Hugel). Hugel merely teaches a polymer including azobenzene units.

Therefore, Applicants submit that the Hugel does not teach or suggest each feature of the claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

C. The Nakagawa Reference

The Examiner alleges that one of ordinary skill in the art would have combined Nakagawa with Stiller to render obvious the claimed invention of claim 17. Applicants submit, however, that even if combined, the alleged combination of references would not teach or suggest each feature of the claimed invention.

Indeed, Applicants submit that claim 17 is patentable at least based on similar reasons to those set forth above with respect to claims 1-8, 11-16, 18, and 19. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

IV. FORMAL MATTERS AND CONCLUSION

In response to Examiner’s objections to the specification, Applicants request the Examiner to refer to the arguments provided above in Section I.

Applicants submit that while the Examiner's objection to claim 19 is clearly erroneous, merely in an effort to speed prosecution, Applicants have canceled claim 19, thus rendering the Examiner's objection moot.

In view of the foregoing, Applicant submits that claims 1-4 and 10-18, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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